

REMARKS

Petition for Revival

This Amendment is filed concurrently with a Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b), together with the requisite fee.

Claim Rejections

Claims 1 to 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paldino (U.S. 5,694,713) in view of Bell (U.S. 5,433,010).

Drawings

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed.

Claim Amendments

By this Amendment, Applicant has amended claim 1 of this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The amended claims are directed toward: a laser pointer mounted on a seat of a firearm as an auxiliary sight, comprising: a cylindrical housing comprising a forward aperture; a light emitting mechanism within the housing, the light emitting mechanism having a forward end fastened in the housing, the light emitting mechanism being adapted to emit light through the aperture to impinge on a target; and an adjustment ring rotatably put on the housing, the adjustment ring comprising an eccentric bore with a rear portion of the light emitting mechanism received therein, *wherein the adjustment ring is configured to be rotated to move the light emitting mechanism laterally a distance.*

As shown in Figures 6 and 7 of the present application, by rotating an adjustment ring 13 provided on the housing 11, the light emitting mechanism 12 is

moved laterally in the eccentric bore 135 by a distance d , such that the direction of the laser beam produced by the light emitting mechanism is shifted laterally. It is important to note that, as taught and recited by Applicant, the adjustment ring 13 moves the light emitting mechanism 12 itself. Furthermore, as taught and recited by Applicant, the adjustment ring 13 physically moves the light emitting mechanism 12 a distance.

In comparison, Paldino teaches a laser sight 2 which, as shown in Figs. 2 and 3, including adjusting ring 30 having two discs which is rotated and moved to tilt the prism 80 so as to redirect/bend the laser beam 38, thus controlling the up and down movement of the emitted laser beam 36. It is important to note that, as clearly shown in Figs. 2 and 3, the prism 80 is tilted by pivoting; the prism 80 is not moved laterally by a distance. Furthermore, it is the prism 80 itself which is tilted and not the laser emitting diode 46. Applicant respectfully notes that the Examiner has incorrectly cited sight laser beam 36 as teaching Applicant's laser light beam source. See, p. 2 of the outstanding Office Action. Rather, sight laser beam 36 is the actual laser beam emitted from the sight 2. The laser emitting diode 46 is the source of the sight laser beam 36.

It follows that Paldino, *inter alia*, does not teach or suggest: a laser pointer mounted on a seat of a firearm as an auxiliary sight, wherein the adjustment ring is configured to be rotated to move the light emitting mechanism. Nor does the reference teach laterally moving the light emitting mechanism a distance.

The secondary reference to Bell fails to teach or suggest the above-noted deficiencies of the primary reference. Instead, Bell teaches a self aligning optical gun sight mount with eccentric adjustment capabilities. As shown in Figs. 9A and 9B, Bell employs a pair of mounting ring means 14, 15 for mounting an optical sight 26 to a firearm, and each of said mounting ring means 14, 15 has an inner surface forming a concave annular seat for contacting the exterior of the tube of the optical sight 26. It is important to note that the reference fails to teach anything about laser sights, much less shifting a light emitting mechanism laterally. Furthermore, as disclosed on p. 4, ll. 20-23, it is the sight 26 which is rotated; the pair of mounting ring means 14, 15 are non-rotably attached to mounting bases 22 by screws 21, as shown in Figs. 2A-2B.

It follows that Bell does not teach or suggest: a laser pointer mounted on a seat of a firearm as an auxiliary sight, including a light emitting mechanism within the housing, the light emitting mechanism having a forward end fastened in the housing, the light emitting mechanism being adapted to emit light through the aperture to impinge on a target. Nor does the reference teach or suggest an adjustment ring configured to be rotated to move the light emitting mechanism; or laterally moving a light emitting mechanism a distance.

As a result, even if the teachings of Paldino and Bell were combined, as suggested by the Examiner, the resultant combination does not suggest: a laser pointer mounted on a seat of a firearm as an auxiliary sight, wherein the adjustment ring is configured to be rotated to move the light emitting mechanism.

Nor does the combination suggest: a laser pointer mounted on a seat of a firearm as an auxiliary sight, wherein the light emitting mechanism is laterally moved a distance.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Paldino or Bell that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Paldino nor Bell disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: May 29, 2007

By:


Demian K. Jackson
Reg. No. 57,551

TROXELL LAW OFFICE PLLC
5205 Leesburg Pike, Suite 1404
Falls Church, Virginia 22041
Telephone: 703 575-2711
Telefax: 703 575-2707

CUSTOMER NUMBER: 40144